

Remarks/Arguments

Claim 46 has been amended to correct a typographical error noted by the Examiner in the last office action. Claims 48-69 have been added. These claims correspond to the claims presented and examined in USSN 10/690,050 that were amended in order to facilitate allowance and isolate the issues for appeal. It was agreed that these claims would be presented in this application to ensure that no rights to the subject matter of the invention would be lost by the agreed upon amendment. No new matter is added by this amendment.

35 USC 112, second paragraph

Claim 46 was rejected as being dependent upon a canceled base claim. The typographical error is regretted and has been corrected.

35 USC 112, first paragraph

The Examiner has rejected claims 44-48 stating that the specification does not describe the invention or enable one of ordinary skill in the art to make or use the full scope of the claims. Claims 49- 52 and 69 are representative and read:

49. (New) A composition characterized by an X-ray fluorescence analysis report wherein the report recites the presence of an element in the periodic table wherein said composition has not been in contact with said element.
50. (New) The composition of Claim 49 comprising a metal.
51. (New) The composition of Claim 49 wherein said composition is manufactured by exposing a starting composition to an iterative cyclic process.
52. (New) The composition of Claim 49 wherein said composition is manufactured by exposing a starting composition to an iterative cyclic process in the presence of a carbon source.

69. (New) The composition of claim 50 or claim 54, wherein said composition comprises gold, silver, tin, lead, zinc, sodium, magnesium, potassium, vanadium, chromium, manganese, tantalum, hafnium, tungsten or alloys thereof.

The following claim has been allowed in USSN 10/690,050:

A composition comprising gold, silver, tin, lead, zinc, sodium, magnesium, potassium, vanadium, chromium, manganese, tantalum, hafnium, tungsten or alloys thereof, characterized by an X-ray fluorescence analysis report wherein the report recites the presence of an element in the periodic table wherein said composition has not been in contact with said element and is manufactured by exposing a starting composition to an iterative cyclic process in the presence of a carbon source.

Claim 49 differs from the allowed claims in that (1) the composition is not limited to specific metals and (2) the limitation that the product be made by an iterative process (in the presence of carbon) has been deleted. Claim 69 reintroduces the specific metals that have been allowed while Claims 51 and 52 reintroduce the iterative process limitations.

With respect to the scope of the elements claimed, given the very divergent number of elements where data has been provided, including metals other than transition metals, such as alkali metals, silicon and aluminum, there is no logical basis for restricting the claims to specific metals and silicon. Applicants have refuted any argument that the observed phenomenon is unique to specific metals. There is no scientific basis presented to conclude that other elements of the periodic table, particularly metals (see Claim 50), could not be similarly modified. It is noted that this basis for rejection should not apply to Claims 44-48 and 57-69.

With respect to the requirement that the claims be limited to the process by which it is made, there is no legal authority presented that supports the proposition that a claim to a product must be limited to the process described in the specification which enables the claimed products, even in an unpredictable art. That is, it is not in dispute that the

specification enables the manufacture of the claimed compositions (at least with respect to the transition metals and silicon), employing such an iterative process (as evidenced by the numerous related patents that have already been issued). Thus, it is not in dispute that the specification teaches at least one enabled process. No more is required under the law. In fact, the USPTO did not require the claims of US Patent 6,572,792, a parent application, to be so limited.

Based upon the breadth of the exemplification provided to date, it is believed that Applicant has satisfied his burden for enabling the full scope of the claims. The USPTO has failed to meet its burden in establishing why the specification is not enabling for the scope of the claims.

Withdrawal of the rejection is respectfully requested.

Double patenting

In order to avoid the new grounds of rejection based under the judicially created doctrine of double patenting, additional terminal disclaimers have been filed herewith.

Conclusion

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (978) 251-3509.

Respectfully submitted,

ELMORE PATENT LAW GROUP, P.C.

/Carolyn S. Elmore/

By _____

Carolyn S. Elmore

Registration No.: 37,567

Telephone: (978) 251-3509

Facsimile: (978) 251-3973

N. Chelmsford, MA 01863

Dated: January 17, 2008